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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,495	07/11/2003	Christian John Lee	C-389 DIV	3998

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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/617,495	Applicant(s) LEE ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is in response to Paper filed on 12 December 2005.

I. Claims 1-5, 10 and 12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Krishnan et al (5,725,646).

Krishnan et al disclose and teach a method for lithographic printing comprising using a water-based (self-dampening) lithographic ink composition comprising from up to 60 wt% of water, up to 10 wt% of glycerol rewetting agent, up to 30 wt% of a CI Pigment Black 6 and 7, up to 70 wt% of a binder, up to 5 wt% a surfactant selected from the known classes of acetylenic glycols, ethoxylated glycols and sorbitan esters. Please see col.3:16-40, 4:8, 10-17 and Example 1 with the use of the ethoxylated acetylenic diol surfactant. As the level of one skilled in the art, it has reasons to believe that at least one of them would have the property of 8-20 hydrophilic/lipophilic balance as claimed in the absence of convincing evidence to the contrary. For a property of a material, please see In re Schreiber, 44 USPQ2d 1429 that it is allowed to requested and required applicants to provide convincing evidence to the contrary since an argument alone is not a factual evidence.

Since Krishnan et al disclose and teach the claimed embodiments, they are found to be anticipated by Krishnan et al.

Applicant's arguments filed 12 December 2005 have been fully considered but they are not persuasive.

Applicants recognize that Krishnan et al disclose and teach the use of glycerol but urge that there are six more chemical ingredients can also be used. It is considered a reasonably small number of chemical ingredients and properly applied.

Applicants show that the applied acetylenic glycols and sorbitan esters have the property of 8-20 hydrophilic/lipophilic balance but urge that those of less than 8 and higher than 20 hydrophilic/lipophilic balance are also known in the art. Those of less than 8 and higher than 20 hydrophilic/lipophilic balance as urged are not applied.

The arguments alone are not found to be convincing since it is not a factual evidence. There is the specific use of the ethoxylated acetylenic diol surfactant in Example 1. The language "having a hydrophilic/lipophilic balance of..." is and considered a functional property of a material (surfactant). For a property of a material, please see In re Schreiber, 44 USPQ2d 1429 that it is allowed to

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requested and required applicants to provide convincing evidence to the contrary since an argument alone is not a factual evidence.

An applicable teaching is not limited to be an example as urged.

II. Claims 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (5,725,646) considered in view of Best (EP 0 079 764) and Wasilewski et al (5,372,635).

Krishnan et al disclose, teach and suggest a method for lithographic printing comprising using a water-based (self-dampening) lithographic ink composition comprising from up to 60 wt% of water, up to 10 wt% of glycerol rewetting agent, up to 30 wt% of a CI Pigment Black 6 and 7, up to 70 wt% of a binder, up to 5 wt% a surfactant selected from the known classes of acetylenic glycols, ethoxylated glycols and sorbitan esters. Please see col.3:16-40, 4:8, 10-17 and Example 1 with the use of the ethoxylated acetylenic diol surfactant. As the level of one skilled in the art, it has reasons to believe that at least one of them would have the property of 8-20 hydrophilic/lipophilic balance as claimed in the absence of convincing evidence to the contrary. For a property of a material, please see In re Schreiber, 44 USPQ2d 1429 that it is allowed to requested and required

applicants to provide convincing evidence to the contrary since an argument alone is not a factual evidence.

Krishnan et al do not specify an amount of a mineral oil as that in claims 6-9, Best at page 4, third paragraph is cited to show the known use of up to about 50 wt% of mineral oil additive in water/oil ink emulsion on page 10, lines 1-15 for the advantage of providing an oil portion in a water/oil emulsion.

Krishnan et al do not specify the selected nonionic surfactants in claim 11. Wasilewski et al at col.3:16-27 is further cited to show the known nonionic surfactants hydrophilic/lipophilic balance for the advantage of reducing surface tension among chemical molecules.

Since the above references are all related to a printing process and ink compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include oil portion from Best in Krishnan et al compositions for a reasonable expectation of providing an oil portion in water/oil ink emulsion to obtain a balancing hydrophilic/lipophilic property for a hydrophilic/lipophilic printing plate in a printing process to provide clearly clear images as disclosed, taught, suggested and obtained in Best and surfactants from Wasilewski et al in Krishnan et al for the advantage of reducing a surface tension

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among chemical molecules as disclosed, taught, suggested and obtained in Wasilewski et al.

Applicant's arguments filed 12 December 2005 have been fully considered but they are not persuasive.

Applicants recognize that Krishnan et al disclose and teach the use of glycerol but urge that there are six more chemical ingredients can also be used. It is considered a reasonably small number of chemical ingredients and properly applied.

Applicants show that the applied acetylenic glycols and sorbitan esters have the property of 8-20 hydrophilic/lipophilic balance but urge that those of less than 8 and higher than 20 hydrophilic/lipophilic balance are also known in the art. Those of less than 8 and higher than 20 hydrophilic/lipophilic balance as urged are not applied. At the level of one skilled in the art, there is much less commercially available nonionic surfactants than those of 8-20 hydrophilic/lipophilic balance as claimed.

The arguments alone are not found to be convincing since it is not a factual evidence. There is the specific use of the ethoxylated acetylenic diol surfactant in Example 1. The language "having a hydrophilic/lipophilic balance of..." is and considered a functional property of a material (surfactant). For a property of a

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material, please see *In re Schreiber*, 44 USPQ2d 1429 that it is allowed to requested and required applicants to provide convincing evidence to the contrary since an argument alone is not a factual evidence.

An applicable teaching is not limited to be an example as urged.

The counsel for applicants signed and support on the submitted Paper that there is no applicable teaching or suggestion of any chemical ingredients in the main body of the specification other than those being limited showing and demonstrate in the working Example 1 in their arguments for the patentability of the instant claims. The reasons as urged on the record should be so limitedly used, applied and considered the same in all cases before an authority or court of law. The record show that the instant application and the applied Krishnan et al (5,725,646) and Wasilewski et al (5,372,635) are all assigned to Sun Chemical Corporation.

In addition, there is no evidence on and for the record that the use of about 0.000 000 001 mg/l of glycerol as broadly claimed and considered in Krishnan would provide any unusual or unexpected result as urged by applicants. Applicants should or provide an evidence to the contrary. It is looking.

Applicants recognize that Best discloses, teaches and suggests the use of mineral oil in a water-in-oil ink emulsion but urge that Best printing ink does not

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have a property of a self-dampening property. (1) For a property of a material (ink composition), please see In re Schreiber, 44 USPQ2d 1429 that it is allowed to requested and required applicants to provide convincing evidence to the contrary since an argument alone is not a factual evidence. (2) The ink composition is already applied with Krishnan et al as primary reference.

Applicants recognize that Wasilewski et al disclose, teach and suggest the use one or more nonionic surfactants having hydrophilic/lipophilic balance of 11-20. Applicants generalize that all surfactant having the property of reducing surface tension including those having hydrophilic/lipophilic balance of 11-20 as applied. It is agreed. But each chemical ingredient would provide a different degree of surface tension reduction. Applicants should show or provided convincing evidence to the contrary.

III. Claims 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al (5,725,646) considered Wasilewski et al (5,372,635).

Krishnan et al disclose, teach and suggest a method for lithographic printing comprising using a water-based (self-dampening) lithographic ink composition comprising from up to 60 wt% of water, up to 10 wt% of glycerol rewetting agent, up to 30 wt% of a CI Pigment Black 6 and 7, up to 70 wt% of a binder, up to 5

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wt% a surfactant selected from the known classes of acetylenic glycols, ethoxylated glycols and sorbitan esters. Please see col.3:16-40, 4:8, 10-17 and Example 1 with the use of the ethoxylated acetylenic diol surfactant. As the level of one skilled in the art, it has reasons to believe that at least one of them would have the property of 8-20 hydrophilic/lipophilic balance as claimed in the absence of convincing evidence to the contrary. For a property of a material, please see In re Schreiber, 44 USPQ2d 1429 that it is allowed to requested and required applicants to provide convincing evidence to the contrary since an argument alone is not a factual evidence.

Krishnan et al do not specify an alkyl phenol and poly oxide derivative thereof as that in claim 9 and an optional amount of mineral oil which may be added to an aqueous containing composition as that in claims 6-8 and 11. Krishnan et al do not specify the selected nonionic surfactants in claim 11. Wasilewski et al at col.3:16-27 is further cited to show the known nonionic surfactants hydrophilic/lipophilic balance for the advantage of reducing surface tension among chemical molecules and col.3:59-67 is cited to show the known use of an mount of mineral oil in an oil-containing printing composition to assist a contact of mineral oil and its soluble agents on lipophilic portions of a lithographic printing plate. There is no suggestion of the "finished printing ink composition" or about the same

on 4:2-13 in this rejection. (1) Since Krishnan et al are related self-dampening lithographic printing processes with the presence of a sufficient amount of water for hydrophilic contacting portion, an optional amount of mineral oil as conventionally known lipophilic contacting agent on lipophilic portions of a lithographic printing plate would not cause an adverse or deleterious processes as reasonably expected in the art. (2) Since a lithographic printing process uses a printing plate with water (hydrophilic)/ oil (lipophilic) portions, there is a need for using an ink with a water/oil balancing ink to obtain sharp images. It is reasonable in the art that mineral oil as a lipophilic contacting agent is known to be used for a reasonable expectation of contacting with lipophilic portion to further providing sharp images.

Since the above references are all related to methods for lithographic printing processes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cite the use of a surfactant and an amount of mineral oil from Kwasniewski et al in Krishnan et al method for reasonable expectations of reducing a surface tension of two or more agents in a liquid composition and assisting a contact of mineral oil on lipophilic portions of a lithographic printing plate for obtaining sharp printed images.

Applicant's arguments filed 12 December 2005 have been fully considered but they are not persuasive.

Applicants recognize that Krishnan et al disclose and teach the use of glycerol but urge that there are six more chemical ingredients can also be used. It is considered a reasonably small number of chemical ingredients and properly applied.

Applicants show that the applied acetylenic glycols and sorbitan esters have the property of 8-20 hydrophilic/lipophilic balance but urge that those of less than 8 and higher than 20 hydrophilic/lipophilic balance are also known in the art. Those of less than 8 and higher than 20 hydrophilic/lipophilic balance as urged are not applied. At the level of one skilled in the art, there is much less commercially available nonionic surfactants than those of 8-20 hydrophilic/lipophilic balance as claimed.

The arguments alone are not found to be convincing since it is not a factual evidence. There is the specific use of the ethoxylated acetylenic diol surfactant in Example 1. The language "having a hydrophilic/lipophilic balance of..." is and considered a functional property of a material (surfactant). For a property of a material, please see *In re Schreiber*, 44 USPQ2d 1429 that it is allowed to

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requested and required applicants to provide convincing evidence to the contrary since an argument alone is not a factual evidence.

An applicable teaching is not limited to be an example as urged.

The counsel for applicants signed and support on the submitted Paper that there is no applicable teaching or suggestion of any chemical ingredients in the main body of the specification other than those being limited showing and demonstrate in the working Example 1 in their arguments for the patentability of the instant claims. The reasons as urged on the record should be so limitedly used, applied and considered the same in all cases before an authority or court of law. The record show that the instant application and the applied Krishnan et al (5,725,646) and Wasilewski et al (5,372,635) are all assigned to Sun Chemical Corporation.

In addition, there is no evidence on and for the record that the use of about 0.000 000 001 mg/l of glycerol as broadly claimed and considered in Krishnan would provide any unusual or unexpected result as urged by applicants. Applicants should or provide an evidence to the contrary. It is looking.

Applicants recognize that Wasilewski et al disclose, teach and suggest the use one or more nonionic surfactants having hydrophilic/lipophilic balance of 11-20. Applicants generalize that all surfactant having the property of reducing

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surface tension including those having hydrophilic/lipophilic balance of 11-20 as applied. It is agreed. But each chemical ingredient would provide a different degree of surface tension reduction. Applicants should show or provided convincing evidence to the contrary.

IV. Krishnan et al (6,200,372) and British Patent No. 1 336 356 are cited to show the known use of surfactant in a lithographic printing inks. Krishnan et al (5,778,789) is cumulative to the above applied Krishnan et al (5,725,646).

V. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
19 January 2006.

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le